

Remarks

Claims 1–20 remain in this application. Claims 2, 7, 10, 17 and 18 have been amended. Claims 1, 10 and 17 are independent claims.

In an Office action dated June 21, 2002, claims 1–4, 7–8, 17 and 19–20 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Tombetti in view of Sells et al. Claims 5–6, 9 and 18 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Tombetti in view of Sells et al. and further in view of Kikinis et al., while claims 10 and 16 were rejected merely over Tombetti in view of Kikinis et al. Claims 11 and 12 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Tombetti in view of Kikinis et al. and further in view of Sells et al., with claims 13–15 being rejected further in view of Yeh et al.

A. Patentability of Claim 1

As described in independent claim 1, Applicants' invention is a method of extending a telephone's capability. A telephone and a computer provide alternative memory stores for call-related data. When first call-related data is received at the telephone and is recognized as being data to be stored in memory, the telephone determines whether the first call-related data will be stored in the telephone memory or in the computer memory. That is, the telephone is the device that is used to determine the location in which the call-related data is to be stored.

In each of the rejections under 35 U.S.C. 103(a), Tombetti is relied upon as the primary reference. In the rejection of claim 1, it is asserted that Tombetti teaches all of the steps of the claimed invention, other than explicitly disclosing the alternative storage of the call-related data in memory located within the computer.

Applicants respectfully assert that the teachings of Tombetti have been misinterpreted and that an accurate reading of the Tombetti reference teaches away from the invention described in the pending claims, so that a *prima facie* case of obviousness has not been presented. The misinterpretation appears to be the result of the unconventional approach of the prior art patent in organizing information within the section entitled "DETAILED DESCRIPTION OF THE INVENTION." Starting at line 9 in column 3 and continuing to line 15 in column 4, the patent does not describe the invention, but instead refers to prior art techniques and problems with the techniques. It is not until column 4, line 16, that the Tombetti reference begins describing the method and system on which the Tombetti invention is

based.

Applicants contend that the description of the prior art techniques in column 3 of Tombetti is incompatible with the description of the techniques described beginning on line 16 of column 4 of the patent. Nevertheless, the Office action bases the Section 103(a) rejection on combining of the incompatible teachings. As one example, the Office action cites column 3 of Tombetti (Fig. 1) for teaching the step of "enabling a computer" to store call-related data, but also cites column 8 (Figs. 3-5) for teaching the step of "enabling a telephone" to store the call-related data. However, the Tombetti patent describes the steps of column 8 as being preferred alternatives to the steps of column 3. Therefore, the prior art patent does not teach the sequence of steps of claim 1 and, in fact, teaches away from the invention described in claim 1.

Fig. 1 of Tombetti shows a system in accordance with the prior art techniques, while the remaining four figures illustrate the Tombetti invention. Thus, in column 2, line 48, it is stated "FIG. 1 is block diagram of a conventional phone system." In this conventional phone system of Fig. 1, a telephone (10) is able to make calls to either a computer (18) or a user (16), who presumably is located at another telephone. The connection between the local telephone (10) and either the computer (18) or the user (16) is through a communication line (14). Column 3 states that some telecommunications terminals, such as telephones, allow a person to access certain on_line services, but the functionality of the terminal (10) is severely limited (Tombetti: column 3, lines 29-32). Therefore, a separate computer (not shown) is used to receive or send data and to carry out complex processes (Tombetti: column 3, lines 33-40). After describing the prior art system of Fig. 1, the patent states, "Although conventional computers and phone systems function separately, those with ordinary skill in the art will realize that each of these systems has drawbacks" (Tombetti: column 3, lines 50-52). The patent states that the drawbacks of a computer system include the expense and the complexity of the system. The drawbacks of a phone system include limited functionality, inability to support peripherals, and inability to change with changes in technology. Therefore, the Tombetti invention is a method and system for providing a telecommunications terminal which is relatively low in cost, but which can be expanded to provide new functions similar to those found in a computer (Tombetti: column 4, lines 16-20). One embodiment of the Tombetti invention is shown in Fig. 2 of the patent. The invention does not include a computer and telephone, as set forth in Applicants' pending claims. Thus, there is no interaction between a computer and a telephone which suggests the computer/telephone

interaction described in the pending claims.

The single-device system of Fig. 2 of Tombetti is described as a multimedia phone (100) (Tombetti: column 4, lines 47–51). The multimedia phone is a system that includes a back panel (150). “In contrast to conventional computer systems which are architected with a central processing unit as a master and other devices as a slave, the system 100 is architected with the back panel 150 as the master” (Tombetti: column 6, lines 10–13). Because of the architecture of the single_device system, “The processing module 152 is a daughter module while the back panel 150 is the mother module” (Tombetti: column 6, lines 56–58). The patent states that the system can also be provided with three other daughter modules (154, 156 and 158) that provide other functions (Tombetti: column 7). Therefore, Applicants respectfully assert that the person of ordinary skill in the art would understand the various modules as being equivalent to different daughter boards that are plugged into the motherboard of conventional computers.

In the rejection of claim 1, the step of determining, within the telephone, whether the call-related data will be stored in the telephone memory or the computer memory is alleged to be taught in column 3, lines 32–49 and column 5, lines 50–65 of Tombetti. As previously asserted, the teachings of these two portions of the patent are incompatible. Column 3, lines 32–49, refers to operations of a “conventional approach in which a computer system and a phone system function separately.” With such an approach, the telephone plays no role in determining whether call-related data will be stored in computer memory. Instead, the user of the two separate systems determines whether to use a telephone to access data or to use a computer to access data. In comparison, the cited portion of column 5 states that the system (100) of Tombetti performs tasks typically performed by a computer. Since the system (100) is described as a multimedia phone that performs tasks typically performed by a computer, there is no teaching or suggestion that the cooperation of a telephone and a computer should occur as set forth in the pending claims.

One of the daughter modules of Tombetti is the handset module (158). This module may be used to control operations of a telecommunications terminal (102) that can be corded or cordless. The cited portion in column 5 of Tombetti states that the hardware modules that may be added may be dedicated to a cellular phone. However, these teachings do not render the claimed invention obvious, since the patent repeatedly and consistently states that the back panel (150) in which the modules are received is the “master,” while the modules are “slaves.” This teaches directly away from the claimed invention, in which the telephone determines whether

call-related data will be stored in a telephone memory or a computer memory.

Claim 1 describes the method as having separate steps of enabling a telephone to store call-related data in memory located within the telephone and enabling a computer to store call-related data in memory located in the computer. For the step of enabling the telephone, the Office action cites column 8, lines 29–35, which notes that FLASH PC memory may be accessed using a PC-MCIA slot. However, for the step of enabling the computer to store the call-related data, the Office action cites column 3, lines 32–49, which is the prior art system to be replaced by the invention of Tombetti. It is respectfully contended that because the conventional system of Fig. 1 in Tombetti is described as having no cooperation between a computer and telephone with regard to call-related data received at the telephone, and because the system of Figs. 2–5 of Tombetti is a device that functions both as a telephone and a computer, the prior art patent does not teach or suggest the steps described in the pending claims.

Sells et al. was cited for teaching the alternative storage of call-related data. The Office action cites column 3, lines 59–65 and column 8, lines 59–62 of the Sells et al. patent. In column 3, lines 59–65, the internal components of the personal computer (12) are identified. The personal computer (12) includes a memory subsystem (31) and a telephony subsystem (14). The telephony subsystem (14) of the personal computer (12) receives incoming calls and transmits outgoing calls over a telephone line (22). This is consistent with the teachings of column 8, lines 59–65, which states that the telephone manager program (104) of the personal computer causes the telephony application interface (110) of the personal computer to transfer control of the telephone line (22) to the appropriate telephony application program of the personal computer. Since both of the cited portions of Sells et al. teach components of the computer, these portions do not teach or suggest alternative storage of call-related data.

Fig. 1 of Sells et al. shows a number of conventional telephones (15, 16 and 17), but the conventional telephones are not described as having alternative storage for call-related data. Sells et al. teaches the transfer of control of a telephone line to the appropriate telephony application program of the personal computer, but the supported telephone does not store the call-related data in the manner described in the pending claims. Therefore, even if one were to modify the primary reference to Tombetti in view of the teachings of Sells et al., the resulting method and system would not render Applicants' claimed invention obvious under Section 103(a).

B. Patentability of Independent Claim 10

Claim 10 describes an apparatus in which components extend the capability of a telephone. The telephone is enabled to receive data from a telephone network and to store the data within the telephone. The telephone is also enabled to determine whether the data received at the telephone will be maintained at the telephone or transferred to a computer.

Claim 10 was rejected over Tombetti in view of Kikinis et al. On page 12 of the Office action, it was asserted that it would be obvious to modify Tombetti to include teachings of Kikinis et al., "since such combination would have added digital telephone capability to the computer as suggested by Kikinis et al. in column 3, lines 20–21." However, the primary patent to Tombetti specifically states that its system (100) of Fig. 2 can provide phone service using both conventional telecommunications terminal lines and digital lines (Tombetti: column 5, lines 50–54). That is, Tombetti teaches that its system is able to provide digital telephone capability without significantly modifying the system. Applicants respectfully assert that a *prima facie* case of obviousness has not been presented, since a person of ordinary skill in the art would not be motivated to incorporate the material and fundamental changes proposed in the Office action merely to substitute one means for achieving digital telephone capability for another means for achieving digital telephone capability, with no apparent benefit to the substitution.

Equally importantly, the primary reference to Tombetti teaches away from the proposed modification. The courts are unanimous in holding that when a primary reference leads away from a proposed modification, the primary reference is persuasive evidence as to the non obviousness of the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed.Cir. 1983). The objective of the Tombetti system was to provide the benefits of traditional telecommunications terminals (such as telephones) and the advantages of a computer (Tombetti: column 2, lines 15–19). Thus, as shown in Fig. 2 of Tombetti, the system is a merger of a telephone and a computer. The merged system overcomes the "drawbacks" of computer systems, as listed in column 3 of Tombetti. Specifically, the system of Fig. 2 in Tombetti overcomes problems such as the expensiveness of a computer system and the difficulty of operation for unsophisticated users. Applicants respectfully assert that it would not be obvious to disregard the clear teachings of Tombetti to modify its system to require operations that involve computer cooperation, as set forth in Applicants' pending claims.

The Office action cites portions of columns 2, 15 and 16 of Kikinis et al. for teaching "means for enabling the telephone to determine whether data received at a telephone will be maintained at the telephone or

transferred to a computer.” The cited portions of columns 15 and 16 describe a portable computer or a desktop computer that has a docking port to receive a micro-personal digital assistant (+PDA). Since the primary reference to Tombetti teaches away from using the computer, Applicants respectfully assert that it would not be obvious to modify the system of Tombetti to include such an arrangement.

Column 2 of Kikinis et al. does state that the prior art invention can retain the look and feel of a conventional telephone, but with docking bays and access to docked modules. However, this embodiment does not teach or suggest Applicants’ claim 10. To more clearly distinguish the invention from the cited prior art, claim 10 has been amended to state that the telephone is enabled to automatically determine without user input whether the data received at the telephone will be maintained at the telephone or transferred to a computer. Applicants respectfully contend that even if the primary reference to Tombetti were modified to include the teachings of Kikinis et al., the resulting apparatus would not render the claimed invention obvious under Section 103(a).

C. Patentability of Independent Claim 17

Claim 17 was rejected as allegedly being unpatentable over Tombetti in view of Sells et al. Claim 17 is similar to claim 1, but relates to processing call-related data, rather than storing call-related data. Therefore, many of the remarks made with regard to the application of Tombetti to Applicants’ claim language apply to claim 17, and are incorporated herein by reference. Nevertheless, Applicants have amended claim 17 to further distinguish the invention from the prior art. Specifically, the step of determining whether the call-related data is to be processed at the telephone or at the computer is identified as being automated processing.

The Office action states that the step of “enabling a first processor in a telephone” is taught by Tombetti at column 6, lines 10–18, while the step of “enabling a second processor resident in a computer” is taught by Tombetti at column 3, lines 32–49. As previously pointed out by Applicants, the teachings of columns 3 and 6 of Tombetti are mutually inconsistent. The teachings of column 3 relate to the “prior art” telecommunications system (1) of Fig. 1, but the teachings of column 6 relate to the multimedia phone system (100) of Fig. 2. Since the multimedia phone system of Fig. 2 in Tombetti is intended to take the place of the conventional telecommunications system of Fig. 1, the patent teaches away from the double “processor enabling” steps that precede the step of using automated

processing capabilities of the telephone to determine the location of the call-related data processing.

In the cited portion of column 6 of Tombetti, the patent states that the back panel (150) functions as a master for the processing module (152). This does not teach or suggest the "double processor enabling" method, since the processing module (152) is a daughter module and the back panel is the mother module (Tombetti: column 6, lines 56–58). That is, in Fig. 2 of the patent, the back panel and the daughter modules are integrated into a single component so that there is not a first processor in a telephone and a second processor in a computer.

The secondary reference to Sells et al. was cited for teaching a method that includes recognizing that call-related data requires further processing in order to transfer control of the telephone line to the appropriate telephony application program. As previously noted, the amendment to claim 17 more clearly distinguishes the invention by stating that the determination within the telephone as to which processor will be used is performed using automated processing capabilities. In the cited portion of column 5 of Sells et al. (i.e., column 5, lines 5–18), the determination is made by a user who enters a data code DTMF using a keypad. This user input is contrary to the method of amended claim 17. On the other hand, the cited portion of column 8 (i.e., column 8, lines 59–62), refers to automated processing, but the processing occurs within the computer and not the telephone. Lines 59–62 state that "the telephone manager program 104 causes the telephony application interface 110 to transfer control of the telephone line 22 to the appropriate telephony application program." All of these elements are contained within the computer, not within the telephone. As noted in column 4, lines 12–20 of Sells et al., Fig. 4 illustrates elements within the personal computer (12) of Figs. 1 and 2. The elements implemented on the personal computer include the telephone manager program 104 and the set of telephony application programs. Similarly, the telephony application interface (110) "is a standardized interface for telephony applications implemented on the personal computer." (Sells et al.: column 4, lines 56–58.) Consequently, Sells et al. does not teach or suggest modifying the method of Tombetti to more closely approach the method of amended claim 17.

Applicants respectfully submit that the amended independent claim 17 and its dependent claims are patentable over the cited prior art.

D. Teachings of Yeh et al.

Claims 13–15 were rejected over Tombetti in view of Kikinis et al. and further in view of Sells et al. and Yeh et al. The secondary reference to Yeh et al. was cited for teaching a computer that lacks computer telephony capability. It was asserted in the Office action that it would be obvious to modify Tombetti/Kikinis et al./Sells et al. to provide an apparatus wherein the computer lacks computer telephony capability. However, Applicants note that this modification would completely destroy the purpose of the Tombetti invention. The Tombetti system (100) of Fig. 2 is specifically designed to provide both computing and telephony capabilities. The stated objective of the Tombetti invention was to achieve a system for providing the benefits of traditional telecommunications terminals and the advantages of a computer (Tombetti: column 2, lines 15–20). It is well established that a modification of a prior art patent which would render the device unworkable for its intended purpose cannot be said to support such a modification. Ex parte Weber, 154 USPQ 491 (P.O.Bd.Ap. 1967). Therefore, a *prima facie* case of obviousness for modifying Tombetti as proposed in the Office action has not been presented.

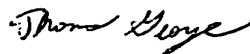
Perhaps more importantly, the Office action evidences a fundamental misunderstanding of the teachings of Yeh et al. The third paragraph on page 15 of the Office action states that Yeh et al. teaches that a computer lacks computer telephony capability in order to provide various telephone functions on the computer with user friendly interfaces using programmable software, and computer and telephony hardware. Two different sections of column 1 of Yeh et al. are cited to support this conclusion. However, the first section relates to the problem that was addressed by the Yeh et al. inventors and the second section relates to the advantages achieved upon resolving the problem. Stated differently, Yeh et al. does not teach that various telephone functions are provided on a computer with user friendly interfaces as a result of the computer lacking telephony capability. To state otherwise appears to be self-contradictory. Rather, the various telephone functions are provided on the computer only because the computer includes telephony capability. As stated in column 2, lines 25–26, the Yeh et al. invention provides a computer having telephone functions using a graphical user interface. The telephone is integrated with the computer by using an interface module which is coupled to the motherboard of the computer. Consequently, even if the other cited references were modified in view of teachings of Yeh et al., the resulting system and method would not teach or suggest the claimed invention.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned "Version with Markings to Show Changes Made."

In accordance with the November 7, 2000 changes to 37 C.F.R. 1.121, a clean set of claims is attached, consolidating all claims currently pending in the application.

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited. In the case that any issues regarding this application can be resolved expeditiously via a telephone conversation, Applicants invite the Examiner to call Terry McHugh at (650) 969-8458.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 2, 7, 10, 17 and 18 have been amended as follows:

1 2. (amended) The method of claim 1 further including a step of establishing a
2 direct data connection between said telephone and said computer, said
3 telephone and said computer being structurally separate components.

1 7. (amended) The method of claim 1 further including steps of:
2 enabling a first processor located within said telephone to
3 process data received at said telephone;
4 enabling a second processor located within said computer to
5 process data received at said telephone;
6 recognizing that said first call-related data received at said
7 telephone is to be processed; and
8 determining, within said telephone, whether said first call-related
9 data will be processed by said first processor or said second processor, said
10 telephone thereby controlling said first call-related data with respect to which
11 of two structurally separate components will perform processing thereon.

1 10. (amended) An apparatus for extending the capability of a telephone
2 comprising:
3 means, located within said telephone, for receiving data from a
4 telephone network;
5 means, located within said telephone, for storing said data
6 received from said telephone network;
7 means, operatively associated with said means for receiving,
8 for enabling said telephone to automatically determine without user input
9 whether said data received at said telephone will be maintained at said
10 telephone or transferred to a computer; and
11 means, operatively associated with said telephone, for trans-
12 ferring said data between said telephone and said computer.

1 17. (amended) A method of extending the capability of a telephone
2 comprising the steps of:

3 enabling a first processor resident in a telephone to process
4 data received at said telephone;

5 enabling a second processor resident in a computer to process
6 data received at said telephone;

7 receiving call-related data at said telephone;

8 recognizing that said call-related data requires further process-
9 ing;

10 determining, [within] using automated processing capabilities of
11 said telephone, whether said call-related data will be processed in said first
12 processor or said second processor, including basing said determination
13 upon automated processing performed by said telephone; and

14 processing said call-related data in either said telephone or
15 said computer based upon said determination made using said automated
16 processing capabilities.

1 18. (amended) The method of claim 17 further including a step of
2 establishing a direct data connection between said telephone and said
3 computer, wherein said telephone and said computer are structurally separate
4 components located within a common workspace and wherein said telephone
5 is configured to perform telephone functions independently of said computer.